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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,362

04/18/2005

Dominique Michel

LP-2002

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FISHER, CHRISTEN & SABOL
1725 K STREET, N.W.
SUITE 1108
WASHINGTON, DC 20006

EXAMINER

YOUNG, SHAWQUIA

ART UNIT

PAPER NUMBER

1626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/520,362

Applicant(s)

MICHEL, DOMINIQUE

Examiner

Shawquia Young

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1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,21-25,31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-8,21-25,31 and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/3/05, 8/22/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-8, 21-25, 31 and 32 are currently pending in the instant application. Applicants cancelled claims 9-20 and 26-30 and added new claims 31 and 32 in an amendment filed on February 13, 2007.

I. Priority

The instant application is a 371 of PCT/EP03/07411, filed on July 9, 2003 which claims benefit to Foreign Application EP 02015229.4, filed on July 9, 2002.

II. Information Disclosure Statement

The information disclosure statements (IDS) submitted on August 3, 2005 and August 22, 2005 are in partial compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been partially considered by the examiner.

III. Restriction/Election

A. Election: Applicant's Response

Applicants' election with traverse of Group I in the reply filed on February 13, 2007 is acknowledged. The traversal is on the ground(s) that: (1) Groups I to IV form a single general inventive concept and should be included together in the restriction requirement.

All of the Applicants' arguments have been considered but have not been found persuasive. It is pointed out that the restriction requirement is made under 35 U.S.C.

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121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted the claimed subject matter accordingly.

Applicants' argue that Groups I to IV form a single general inventive concept and should be included together in the restriction requirement. In independent Claim 1, R¹ and R² are each defined as a Markush group. In the Examiner's definition of each Groups I to IV, R² is stated to be as defined in Claim 1. Further, in each of Groups I to IV, R¹ is C₁₋₈alkyl, phenyl, furanyl and thienyl, respectively. All of these species or subgroup provide the same utility in the invention and share a substantial structural feature essential to that utility. The definition of R¹ in Groups I to IV, in essence, form a Markush group that has utility. The definition of R¹ in Groups I to IV, in essence, form a Markush group that has unity of invention. However, the Examiner wants to point out that the independent claim 1 is drawn to a process for the preparation of a compound of formula I. Since the compound of formula I is the final product, the special technical feature is related to the final product of the claimed process. The special technical feature is defined by the Examiner as the core structure of the final product of the claimed process excluding the variables. The core structure of the final product does not define a contribution over the prior art (See, Hill et al., for example).

There are two requirements that have to be met when considering unity of invention in relation to Markush practice as mentioned in Applicants arguments on

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pages 13-14. "When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled: (A) All alternatives have a common property or activity; and (B)(1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives; or (B)(2) In case where the common structure cannot be the unifying criteria, all alternative belong to a recognized class of chemical compounds in the art to which the invention pertains". The Examiner agrees that part (A) has been fulfilled where there is a common property or activity but part (B) has not fulfilled. The various final products of formula I being prepared according to claim 1 are structurally different and classified differently. For example, R^1 can be an alkyl group, phenyl ring, or thienyl ring. The thienyl group is a heterocyclic ring and therefore controls the classification of the final product. The final product would be classified in 549 but when R^1 is alkyl than the final product might be classified in 564 depending on what group R^2 represents. The Examiner further states that prior art found on Group I cannot necessarily be used as prior art against Group IV. So therefore, these groups are considered different inventions. However, the Examiner will combine groups I and II since these two groups would be classified similarly. Groups III and IV will not be rejoined because these two groups are classified in different classes from Groups I and II whether you classify the groups according to a process of preparing (Class 514) or a final product (Class 549).

Applicants also argue that the Examiner has not factually shown in the record that Wilkerson supports the Examiner's position when using the US Patent 4,949,183 as a reference to show that Applicants invention has lack of unity. The Examiner wants to

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point out that the reference is only being used to show what is in the prior art and that the Applicants special technical feature (i.e. the final product of formula I) does not provide a contribution over the art. Therefore it is not required to obtain support from the inventorship of the patent of the Examiner's position that the instant application has a lack of unity.

Therefore the Lack of Unity between groups I, III and IV indicated in the Restriction Requirement are maintained.

The Examiner has to search the claimed invention thoroughly and that includes searching the process as well as the final product. Since the final products can be classified in various classes, different search considerations are involved (i.e., class/subclass searches, databases searches, etc.) for each of the groups listed. The inventions are classified into classes for example, 514, 549 and 564. However, each Class 514, 549, 564 encompasses numerous patents and published applications. For instance, Class 514 contained 165,171 patents and published applications. Therefore it would constitute a burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety.

Subject matter not encompassed by elected Groups I and II are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

IV. Objections

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Claim Objection-Non Elected Subject Matter

Claims 1-8, 21-25, 31 and 32 are objected to as containing non-elected subject matter. To overcome this objection, Applicant should submit an amendment deleting the non-elected subject matter.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because for exceeding 150 words.

Correction is required. See MPEP § 608.01(b).

V. Conclusion

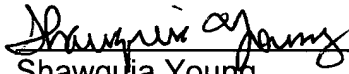
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

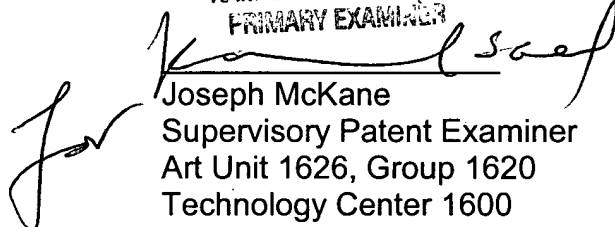
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number

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for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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